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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/628,098	07/27/2000	Khai Hee Kwan		3200

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EXAMINER

AKINTOLA, OLABODE

ART UNIT	PAPER NUMBER
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3691

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04/16/2008

PAPER

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary	Application No. 09/628,098	Applicant(s) KWAN, KHAI HEE	
	Examiner OLABODE AKINTOLA	Art Unit 3691	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 03 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-5,8,21-26,28,29,31,33,34 and 36-39 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-5,8,21-26,28,29,31,33,34 and 36-39 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- | | |
|--|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892) | 4) <input type="checkbox"/> Interview Summary (PTO-413) |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948) | Paper No(s)/Mail Date. _____ |
| 3) <input type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08) | 5) <input type="checkbox"/> Notice of Informal Patent Application |
| Paper No(s)/Mail Date _____ | 6) <input type="checkbox"/> Other: _____ |

DETAILED ACTION

Claim Rejections - 35 USC § 112

The following is a quotation of the first paragraph of 35 U.S.C. 112:

The specification shall contain a written description of the invention, and of the manner and process of making and using it, in such full, clear, concise, and exact terms as to enable any person skilled in the art to which it pertains, or with which it is most nearly connected, to make and use the same and shall set forth the best mode contemplated by the inventor of carrying out his invention.

Claims 1-5, 8, 21-26, 28-29, 31, 33-34, 36-39 are rejected under 35 U.S.C. 112, first paragraph, as failing to comply with the written description requirement. The claim(s) contains subject matter which was not described in the specification in such a way as to reasonably convey to one skilled in the relevant art that the inventor(s), at the time the application was filed, had possession of the claimed invention.

In particular, claims 1, 21 and 25 disclose the step of “receiving a request to post a requirement to syndicate a loan opportunity by a first entity over a network”. This step is not supported or disclosed in the original disclosure and therefore constitutes new matter. Applicant is requested to cite relevant portion(s) of the original disclosure that teaches this limitation.

Claim Rejections - 35 USC § 103

The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person

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having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

The factual inquiries set forth in *Graham v. John Deere Co.*, 383 U.S. 1, 148 USPQ 459 (1966), that are applied for establishing a background for determining obviousness under 35 U.S.C. 103(a) are summarized as follows:

1. Determining the scope and contents of the prior art.
2. Ascertaining the differences between the prior art and the claims at issue.
3. Resolving the level of ordinary skill in the pertinent art.
4. Considering objective evidence present in the application indicating obviousness or nonobviousness.

Claims 1, 3, 8, 21, 23, 26, 31, 33 and 36 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tengel et al (USPN 5940812) (“Tengel”) in view of Adam et al (US 6898636) (“Adams”) and further in view of Connolly, J (“S&P Starts New Service for Rating Private Placements”, Dec. 21, 1992) (“Connolly”)/Goldblatt, J (“Fitch creating a database to Rate Buyout Firms on How well Targets Fare Series: 11” American Banker, N.Y. Oct. 15, 1997) (“Goldblatt”).

Re claims 1, 21, 25 and 26: Tengel teaches method operative at a server for negotiating and managing loan syndication over a network, comprising the steps of: receiving a request to post a requirement to syndicate a loan opportunity by a first entity over a network (col. 2, lines 59-67); displaying information about said requirement accessible by any entities over said network (Figs. 1, 3A-B; col. 3, lines 39-44).

Tengel does not explicitly teach, in response to said requirement, said first entity receiving an online comment from one or more second entities about conditions and terms of said loan opportunity over said network; in response to said comment, enabling said first entity to negotiate said conditions and terms with said second entity or other different second entities over

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said a network about committing at least a portion of said loan opportunity in aggregate with different entities forming a loan syndicate; providing ratings associated with the entities based on past syndication data; and whereby said loan opportunity is pending agreement.

Adams teaches, in response to said requirement, said first entity receiving an online comment from one or more second entities about conditions and terms of said loan opportunity over said network (col. 6, lines 22-54); in response to said comment, enabling said first entity to negotiate said conditions and terms with said second entity or other different second entities over said a network about committing at least a portion of said loan opportunity in aggregate with different entities forming a loan syndicate (col. 6, lines 22-54); and whereby said loan opportunity is pending agreement (col. 6, lines 22-54). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tengal to include these features as taught by Adams for the obvious reason of negotiating the terms of the loan carried out over a network.

Connolly/Goldblatt teaches providing ratings associated with the entities based on past syndication data (Connolly: Abstract; Goldblatt: paragraphs 8-19). It would have been obvious to one of ordinary skill in the art at the time of the invention to rate lenders based on their past syndication performance.

Re claims 3, 23 and 33: Adams teaches providing a feedback routine for commenting about the entities and said feedback is submitted by the entities over said network (col. 6, lines 22-54).

Re claims 4, 28 and 34: Tengal teaches that the requirement is a lending and first entity is a potential lender (Figs. 1, 3A-B; col. 3, lines 39-44).

Re claims 8, 31 and 36: Tengel does not explicitly teach updating online documents incorporating said negotiated conditions and terms before creating the loan syndicate by agreement. Adams teaches updating online documents incorporating said negotiated conditions and terms before creating the loan syndicate by agreement (col. 6, lines 22-54; col. 17, lines 38-48). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tengel to include these features as taught by Adams for the obvious reason of closing the deal based on finalized negotiation.

Claims 2 and 24 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tengel in view of Adams in view of Connolly/Goldblatt and further in view of Walker et al (US 5884270) (“Walker”).

Re claims 2 and 24: Tengel does not explicitly teach that the entities are anonymous. Walker teaches a system that allows party to remain anonymous while negotiating an agreement (col. 23, lines 7-9). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tengel to include anonymizing identities of the parties in order to protect the identities of the parties until an agreement has been reached, thereby enhancing the effectiveness of the system.

Claims 5, 22 and 29 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tengel in view of Adams in view of Connolly/Goldblatt and further in view of Herschkorn (US 6691094) (“Herschkorn”).

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Re claims 5, 22 and 29: Tengel does not explicitly teach an auction routine for entities to place loan commitment bids and whereby more than one entity can be selected forming the loan syndicate. Herschkorn teaches a method for conducting loan auctions (partially filled by more than one bid) over a network (col. 17, line 55 through col. 18, line 14). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tengel to include this auction feature in order determine entities to form the loan syndicate cumulatively, when a single entity is not able to provide the required loan.

Claims 37-39 are rejected under 35 U.S.C. 103(a) as being unpatentable over Tengel in view of Adams in view of Connolly/Goldblatt in view of Herschkorn and further in view of Dubner (US 6564190) ("Dubner").

Re claims 37-39: Tengel/Herschkorn teaches determining whether to accept or reject for each of said offers (Tengel: col. 4, lines 41-45; Herschkorn: col. 17, line 55 through col. 18, line 14). Furthermore, Tengel teaches ranking of best loans. However, both Tengel and Herschkorn do not explicitly teach determining best offer in terms of a risk-return matrix satisfying at least both minimum cost and total loan amount sought for said requirement; and determining by said first entity whether to accept or reject for each of said offers. Dubner teaches the feature risk/reward matrix (col. 3, lines 34-36, Fig. 2).). It would have been obvious to one of ordinary skill in the art at the time of the invention to modify Tengel to include this feature in order to achieve optimal bid selections for the loan syndicate.

Response to Arguments

Applicant's arguments filed 03/03/2008 have been fully considered but they are not persuasive.

35 USC 112 (1):

Applicant cited page 2, lines 12-19, page 6, lines 3-9, page 11, lines 4-6 (fig 6), page 19, lines 21-22 and page 33, lines 21-23 of the specification as providing support for the limitation “receiving a request to post a requirement to syndicate a loan opportunity by a first entity over a network”. Examiner respectfully disagrees with the characterization of the aforementioned passages. The Examiner interpretation of the passages is that the requirement to syndicate a loan opportunity is already resident in the server and while the lenders may retrieve this information from the server, the loan syndicates and originators do not "post" this information as a result of a request. The word “post” suggests inputting and uploading information to the server or host which does not require “a request”. The requirement is not posted as a result of a request by a first entity as recited in the claims. The first entity merely requests the information (requirement to syndicate a loan opportunity) and not “a request to post”.

35 USC 103(a):

Applicant argues that Tengel's teaching fails to teach “requirement to syndicate a loan opportunity” as recited in the claims. Examiner respectfully disagrees. Examiner interprets “requirement to syndicate a loan opportunity” as simply a loan criteria or requirement for the loan. The differences are only found in the nonfunctional descriptive material and are not functionally involved in the method (or structurally programmed) steps recited. The steps would be performed the same regardless of type of loan (i.e. syndicate, regular loan, refinance, etc).

Thus, this descriptive material will not distinguish the claimed invention from the prior art in terms of Patentability, see *In re Gulack*, 703 F.2d 1381, 217 USPQ 401, 404 (Fed. Cir. 1983); *In re Lowry*, 32 F.3d 1579, 32 USPQ2d 1031 (Fed. Cir. 1994). Therefore, it would have been obvious to one of ordinary skill at the time of the invention to have received any type of loan requirement. Such loan requirement does not functionally relate to the steps and the subjective interpretation of the loan requirement does not patentably distinguish the claimed invention.

Applicant also argues that the Tengel reference does not specifically states displaying information and that there is no explicit teaching of accessible by any entities. Examiner respectfully disagrees. Tengel in Fig. 3A-B explicitly shows a display of information (loan criteria). Also, the word entities is not defined in the claims. Examiner interprets entities as lenders. It is noted that the features upon which applicant relies (i.e., *all* entities including lenders and borrowers) are not recited in the rejected claim(s). Although the claims are interpreted in light of the specification, limitations from the specification are not read into the claims. See *In re Van Geuns*, 988 F.2d 1181, 26 USPQ2d 1057 (Fed. Cir. 1993).

In response to applicant's argument regarding the combination of the references, the test for obviousness is not whether the features of a secondary reference may be bodily incorporated into the structure of the primary reference; nor is it that the claimed invention must be expressly suggested in any one or all of the references. Rather, the test is what the combined teachings of the references would have suggested to those of ordinary skill in the art. See *In re Keller*, 642 F.2d 413, 208 USPQ 871 (CCPA 1981).

Conclusion

THIS ACTION IS MADE FINAL. Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire THREE MONTHS from the mailing date of this action. In the event a first reply is filed within TWO MONTHS of the mailing date of this final action and the advisory action is not mailed until after the end of the THREE-MONTH shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than SIX MONTHS from the mailing date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OLABODE AKINTOLA whose telephone number is (571)272-3629. The examiner can normally be reached on M-F 8:30AM -5:00PM.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Alexander Kalinowski can be reached on 571-272-6771. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OA

/Hani M. Kazimi/
Primary Examiner, Art Unit 3691